

a [seal] gasket having opposite first and second surfaces and an outer peripheral edge that extends around the first and second surfaces, a [seal] gasket opening positioned on the [seal] gasket and extending between the first and second surfaces for passage of an object through the [seal] gasket opening, a wall projecting outwardly from the [seal] gasket first surface, the wall being spaced inwardly from the outer peripheral edge and extending around the [seal] gasket opening defining a cavity within the wall and adjacent the [seal] gasket opening; and,

a sealant positioned in the cavity sealing the [seal] gasket opening.

Claim 2 (Amended) The assembly of Claim 1, wherein:

the [seal] gasket is constructed of a resilient material that enables the [seal] gasket opening to be stretched around an object passed through the [seal] gasket opening.

Claim 4 (Amended) The assembly of Claim 1, wherein:

the [seal] gasket opening is centered within the wall.

Claim 5 (Amended) The assembly of Claim 1, wherein:

the [seal] gasket opening is the only opening through the [seal] gasket within the wall.

Claim 6 (Amended) The assembly of Claim 1, wherein:

the [seal] gasket opening is circular and the wall is circular and concentric with the [seal] gasket opening.

Claim 7 (Amended) In a device that seals between an electric motor and a conduit enclosure attached to the motor and that seals around leads of the motor that pass through a motor lead opening of the motor and an enclosure lead opening of the conduit enclosure, an improvement comprising:

a [seal] gasket having opposite first and second surfaces, the first surface engaging against the conduit enclosure and the second surface engaging against the motor, a [seal] gasket lead opening positioned on the [seal] gasket for passage of the leads through the [seal]

gasket lead opening, a wall projecting outwardly from the [seal] gasket first surface and extending around the [seal] gasket lead opening defining a cavity within the wall and adjacent the [seal] gasket lead opening; and

a sealant positioned in the cavity sealing the [seal] gasket lead opening and sealing around leads passed through the [seal] gasket lead opening.

Claim 8 (Amended) The device of Claim 7, wherein:

the [seal] gasket is constructed of a resilient material that enables the [seal] gasket lead opening to be stretched around leads passed through the [seal] gasket lead opening.

Claim 12 (Amended) The device of Claim 7, wherein:

the wall projects outwardly from the [seal] gasket first surface a distance that enables the wall to pass completely through the enclosure lead opening.

Claim 13 (Amended) A motor comprising:

a motor shell and leads that exit the motor shell through a lead opening in the motor shell;

a conduit box having a bottom wall and side walls extending at an angle from the bottom wall, the bottom wall and side walls of the conduit box defining an interior of the conduit box, the bottom wall having a conduit box lead opening and the bottom wall being [configured and adapted to attach] attached to the motor shell so that the lead opening in the bottom wall is aligned with the motor shell lead opening;

a gasket [configured and adapted to be] positioned between the conduit box and the motor shell to provide a liquid tight seal between the conduit box and the motor shell so that no liquid can enter the conduit box or the motor shell through the conduit box lead opening or the motor shell lead opening, the gasket having opposite first and second surfaces, the first surface having a projection that extends outwardly from the first surface and has a cavity within the projection, the cavity has a lead opening that extends through the gasket and aligns with the

conduit box lead opening and the motor shell lead opening so that the leads extend from the motor, through the motor shell lead opening, through the gasket cavity lead opening, through the conduit box lead opening and into the conduit box interior; and

a sealant residing in the gasket cavity, the sealant forming a liquid tight seal between the gasket cavity and the leads while limiting the sealant from coming in contact with the conduit box lead opening or the motor shell lead opening, the gasket thereby allowing the conduit box to be removed from the motor shell and rotated to an alternate orientation relative to the motor shell and reattached to the motor shell in the alternate orientation without breaking the seal between the leads and the gasket cavity formed by the sealant.

Claim 21 (Amended) A method of sealing a lead opening on a motor, the method comprising the steps of:

providing a motor in a motor shell, the motor having leads extending from the motor, providing a lead opening in the motor shell and positioning the leads through the lead opening in the motor shell;

providing a conduit box having a bottom wall and an interior, providing a lead opening in the bottom wall;

providing a gasket [with a configuration that is adapted to be positioned] and positioning the gasket between the conduit box and the motor shell to form a liquid tight seal between the gasket and the conduit box and between the gasket and the motor shell, providing the gasket with opposite first and second surfaces and a projection extending outwardly from the first surface, forming a cavity in the projection with the cavity having a lead opening that extends through the gasket first and second surfaces;

extending the motor leads through the gasket cavity lead opening;

placing the gasket on the motor shell so that the gasket cavity lead opening is aligned with the motor shell lead opening and so that the leads pass through the gasket cavity lead opening;

attaching the conduit box to the motor shell so that the gasket is between the conduit box and the motor shell and so that the gasket cavity lead opening is aligned with the conduit box lead opening and the leads pass through the conduit box lead opening and into the conduit box interior; and

applying a sealant in the gasket cavity so that the sealant forms a liquid tight seal between the leads and the gasket projection.

#### **Remarks**

In the Office Action of Paper No. 5 the specification was objected to for not supporting the use of the word "seal" in Claims 1 through 12. Claims 1 through 12 have been amended herein replacing "seal" with "gasket." It is believed that these amendments to Claims 1 through 12 overcome the basis for the objection to the specification.

Claims 1, 2 and 5 were rejected under 35 USC Section 102(b) as being anticipated by the patent publication of Morimoto (JP 4-075, 444). Of the rejected claims, Claim 1 is an independent claim and Claims 2 and 5 depend directly from Claim 1. It is respectfully submitted that the subject matter of the Morimoto reference does not disclose the subject matter recited in original Claim 1 or in Claim 1 as amended herein.

As stated earlier, Claim 1 has been amended replacing the word "seal" with the word "gasket." Additional structural limitations of the invention have also been added to Claim 1. However, Claim 1 as originally filed was not anticipated by the Morimoto reference. Claim 1 recites a gasket having opposite first and second surfaces, an opening on the gasket for passage of an object through the opening, a wall projecting outwardly from the gasket first surface and extending around the opening defining a cavity within the wall and adjacent the

opening, and a seal in the cavity sealing the opening. In contrast, what is interpreted as the claimed seal in Morimoto appears to be a plug 30 with two openings 31 passing through the plug. The plug has no wall that projects outwardly from a first surface of the plug and extends around an opening through the plug defining a cavity within the wall. The rejection refers to Figure 1 of Morimoto and states that it discloses a wall extending from an upper lip. However, the Morimoto reference clearly fails to disclose a wall extending around an opening in a gasket that also defines a cavity within the wall. Still further, the reference clearly fails to disclose a sealant positioned within the cavity defined by the wall. Because the Morimoto reference fails to identically disclose the subject matter of the invention recited in Claim 1, it does not anticipate that subject matter. Therefore, Claim 1 is allowable over the Morimoto reference.

Claims 2 and 5 depend from Claim 1 and are therefore also allowable.

Claims 1, 2, 5 and 7-9 were rejected under 35 USC Section 102(b) as being anticipated by the disclosure of the Hatsutori, et al. patent publication (JP 58-192,450). Of the rejected claims, Claims 1 and 7 are independent claims. Claim 1 has been amended herein to set forth that the first and second surfaces of the gasket have an outer peripheral edge that extends around the first and second surfaces and that a wall projects outwardly from the first surface, the wall being spaced inwardly from the outer peripheral edge of the gasket, and the wall extending around an opening in the gasket defining a cavity within the wall adjacent the opening. In the rejection of the claims, the Hatsutori reference is said to disclose a seal or gasket 16 having an opening 16a in a wall 16c extending from the first surface of the gasket with a resin sealant within the wall. However, the Hatsutori reference does not disclose a wall projecting outwardly from a first surface of the gasket where the wall is spaced inwardly from the outer peripheral edge of the gasket first surface as recited in amended Claim 1. The Hatsutori gasket shown in Figure 10 is bounded by the circular wall 16c and no portion of the gasket

extends beyond the wall 16c. Therefore, the reference fails to anticipate the subject matter of Claim 1 and Claim 1 is allowable.

Claims 2 and 5 depend from amended Claim 1 and therefore are also allowable.

Claim 7 has been amended herein to recite the gasket having opposite first and second surfaces where the first surface engages against the conduit enclosure and the second surface engages against the motor. The Hatsutori reference fails to disclose any gasket having opposite first and second surfaces where the gasket is positioned between a motor and a conduit enclosure so that the first surface of the gasket engages against the conduit enclosure and the second surface of the gasket engages against the motor. Therefore, the reference does not anticipate the subject matter of Claim 7 and Claim 7 is allowable.

Claims 8 and 9 both depend from Claim 7 and are therefore also allowable.

Claims 1, 2, 4-8, 21 and 22 were rejected under 35 USC Section 102(b) as being anticipated by the U.S. Patent of Smith No. 1,799,071. In the rejection it is stated that the Smith reference discloses a motor housing 4, a gasket and a terminal box 21. However, the explanation of how the gasket of the Smith reference discloses the features of the invention recited in the rejected claims is unclear.

Of the rejected claims, Claims 1, 7 and 21 are independent claims. Claim 1 recites a gasket with opposite first and second surfaces, a wall projecting from the first surface and defining a cavity within the wall, and a sealant positioned in the cavity.

In a like manner, Claim 7 recites a gasket having opposite first and second surfaces, a wall projecting outwardly from the gasket first surface and defining a cavity within the wall, and a sealant within the cavity.

Claim 21 recites positioning a gasket between a conduit box and a motor shell where the gasket has opposite first and second surfaces, the first surface has a projection that extends

outwardly from the first surface and has a cavity within the projection, and a sealant residing in the gasket cavity.

All of the independent claims set forth above are similar in their reciting the basic combination of a gasket with a wall or projection defining a cavity within the wall or projection, and a sealant within the cavity.

In contrast to the above, the Smith reference does not disclose a gasket and sealant combination. The reference discloses an incremable substance 23 within a thimble that extends from a conduit box 21 to the end ring 5 of the motor. The reference is not remotely related to the subject matter of the invention that requires the combination of a gasket and a sealant. Therefore, the Smith reference fails to anticipate the subject matter of Claim 1 and its dependent Claims 2 and 4-6, and fails to anticipate the subject matter of Claim 7, and its dependent Claim 8, and fails to anticipate the subject matter of Claim 21 and its dependent Claim 22. For the reasons set forth above, it is respectfully submitted that the rejected claims are allowable over the Smith reference.

Claims 3, 10, 13, 14 and 17 were rejected under 35 USC Section 103(a) as being obvious in view of the Smith reference and further in view of the German patent publication DE 30 11 975. In the rejection it is contended that the Smith reference teaches every aspect of the invention except for the sealant only being in the wall or projection cavity. However, as set forth above with regard to Claims 1 and 7 from which Claims 3 and 10 depend, respectively, the Smith reference does not remotely disclose the subject matter of the invention recited in the claims. These features of the invention are also recited in independent Claim 13 from which Claims 14 and 17 depend. The Smith reference does not disclose or suggest the basic combination of the invention of the gasket with a wall surrounding a cavity and a sealant within the wall cavity. The shortcomings of the Smith reference are not overcome by the German patent publication. The German publication, being a foreign prior art reference, must be strictly

construed for what it identically discloses. The publication fails to disclose a gasket having opposite first and second surfaces, a wall projecting outwardly from the first surface and defining a cavity and a sealant within the cavity as recited in Claim 1 from which Claim 3 depends, Claim 7 from which Claim 10 depends, Claim 13 and its depending Claims 14 and 17. Because the Smith reference does not remotely suggest the subject matter of the rejected claims, the claims are allowable over the prior art of record.

Claims 11, 12, 15, 16, 23, 24, 27 and 28 were rejected under 35 U.S.C. Section 103(a) as being obvious in view of the Smith reference in combination with the German patent publication DE 30 11 975. In this rejection it is again contended that the Smith reference discloses every aspect of the invention except the wall being inserted into the enclosure lead opening without contacting the enclosure and with the wall extending completely through the enclosure opening. The rejection also refers to a Horvath reference that is not of record in the application file. For this reason alone the rejection cannot be understood. Furthermore, the rejection appears to rely on an interpretation of the German reference that is not supported by the limited translation of the basic abstract of the reference. The rejection states that the German reference "teaches the cable block 3 inserted with an opening between the case and the block". However, the abstract of the reference states that the reference discloses a "terminal box that has flat support pieces (5) fixed in the thickened edge region around the sealed central hole (3A) of the support base (3)." Regardless, neither reference clearly shows or suggests a gasket having opposite first and second surfaces, a hole extending through the gasket, a wall or projection extending outwardly from the gasket first surface and having a cavity within the wall or projection, the opening being within the cavity and a sealant within the cavity. Because the references do not remotely disclose the subject matter of the invention recited in claim 7 from which claims 11 and 12 depend, recited in claim 13 from which claim 16 depends and recited in claim 21 from which claims 23, 24, 27 and 28 depend, the references do not



make obvious the subject matter of the rejected claims and the claims are allowable over the prior art.

Claims 18 and 25 were rejected under 35 U.S.C. Section 103(a) as being obvious in view of the Smith reference in combination with the Morimoto reference. Again it is stated in the rejection that the Smith reference teaches every aspect of the invention except the gasket cavity having a peripheral edge to hold the wires. Claim 18 depends from independent claim 13 and claim 25 depends from independent claim 21. As pointed out above, the Smith reference fails to remotely suggest the subject matter of the invention recited in claims 18 and 25. The Smith reference only discloses an incremable substance in a thimble positioned between a motor and a conduit box. There is no disclosure or suggestion of the combination of a gasket with a sealant, much less a gasket having opposite first and second surfaces with a projection extending from the first surface, a cavity in the projection and a lead opening in the cavity that extends through the gasket as recited in claims 13 and 21 from which claims 18 and 25 depend, respectively. The disclosure of the Smith reference is so remote from the subject matter of the application that it clearly would not be obvious to combine the teachings of Morimoto with the Smith reference. Furthermore, if such a combination were possible the Morimoto disclosure fails to overcome the shortcomings of the Smith reference as set forth earlier in this Amendment and Response. Therefore, the subject matter of claims 18 and 25 is not obvious in view of the combined references and these claims are allowable over the prior art.

Still further, claim 18 depends from claim 14 which depends from claim 13. Claims 13 and 14 have been previously rejected in view of Smith and the German patent publication. Therefore, the rejection of claim 18 in view of only the Smith reference combined with the Morimoto reference appears to be improper and should be withdrawn.

Claims 19 and 26 were rejected under 35 U.S.C. Section 103(a) as being obvious in view of the Smith reference in combination with the U.S. Patent of Bryant et al. #5,889,343. In

this rejection it is again contended that the Smith reference teaches every aspect of the invention except the seal being an epoxy. The Bryant reference is relied on for such a disclosure. However, as set forth above, the Smith reference fails to disclose or remotely suggest the basic combination of the invention of a gasket with a sealant. Still further, the Smith reference clearly does not remotely disclose a gasket having opposite first and second surfaces, a projection on the gasket first surface, a cavity in the projection, a lead opening in the cavity and extending through the gasket and a sealant in the gasket as recited in independent claims 13 and 21 from which claims 19 and 26 depend, respectively. Because the combined references fail to remotely suggest the subject matter of the invention set forth in the rejected claims, they fail to make obvious that subject matter and claims 19 and 26 are allowable over the prior art. Furthermore, claim 19 depends directly from claim 13 which was previously rejected in view of the combination of the Smith reference and the German patent publication. Therefore, rejecting claim 19 in view of Smith in combination with the Bryant reference appears to be improper and should be withdrawn.

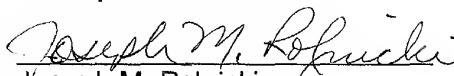
Claim 20 was rejected under 35 U.S.C. Section 103(a) as being obvious in view of Smith in combination with the U.S. Patent of Hillix #1,646,962. In the rejection it is again contended that the Smith reference discloses every aspect of the invention except the conduit box being curved. The Hillix reference is relied on for this disclosure. However, as set forth above, the Smith reference fails to remotely disclose the basic concept of the invention of a gasket in combination with a sealant. Furthermore, the references clearly fail to remotely disclose a gasket having opposite first and second surfaces, a projection extending outwardly from the gasket first surface and a cavity within the projection, the cavity having a lead opening that extends through the gasket and a sealant in the gasket cavity. Because both references fail to remotely disclose the subject matter of the invention recited in claim 13 from which claim 20

depends, the references fail to make obvious the subject matter of the invention recited in the claim and claim 20 is allowable over the prior art.

It is respectfully submitted that in view of the amendments and remarks presented herein, the application is in condition for allowance and favorable action is requested.

Respectfully submitted,  
**Thompson Coburn LLP**

By:



Joseph M. Rolnicki

Reg. No. 32,653

One US Bank Plaza

St. Louis, MO 63101-1693

(314) 552-6286